REMARKS

Applicant notes with appreciation the allowance of claims 57 and 58.

Claims 59 – 66 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia et al. (US Patent No. 5,825,880). This rejection is respectfully traversed with respect to the amended claims.

First of all, the claims have been amended to cover only a system that includes a personal computer. There is no suggestion of such a system in Sudia et al., since, as the Examiner says, the "computer" is considered to be the smart card.

Secondly, there are a number of other limitations of the rejected claims that are missing in Sudia et al. While a noise source is suggested, noise sources can be used to generate true random numbers or pseudo random numbers, as shown by Vaughan. Moreover, a smart card really is not a computer, and would not include a device driver, a TSR, a portion of the operating system of said computer, a program stored in the bios memory of a computer, and certainly does not include an add-on board; more importantly, Sudia et al. certainly does not say that any of these are in the smart card. Thus, the Office Action is really using the disclosure of the present invention to make the rejection. MPEP 2145X.A, and *W.L. Gore & Associates, Inc. v. Garlock*, 220 U.S.P.Q. 303, 311-13 (Fed. Cir. 1983).

Further, Sudia et al., is probably not prior art. It is a continuation of an application filed on June 5, 1995, while the present application is a divisional of an application filed on February 14, 1995. While Sudia et al. is also a continuation-in-part of several earlier filed applications, the Examiner is relying on just two lines of Sudia et al., and there is no evidence that those lines were in the prior applications.

Claims 59 – 66 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Vaughan (US Patent No. 4,800,590). This rejection is respectively traversed. As admitted in the Office Action, Vaughan does not disclose a means for interfacing. The Examiner says that such a means is obvious. It is hard to believe that the Examiner thinks that a lock as in Vaughan suggests a device driver, a TSR, a portion of the operating system of said computer, a program stored in the bios memory of a computer, and an add-on board. The Office Action also does not respond to the fact pointed out in the last response that

Vaughan uses the random signals produced by true random number generator 80 as a seed input to produce the *pseudorandom number* sequence to be used by the Vaughan system. See column 5, line 43 – column 6, line 32. All of the limitations of a claim must be taught by the cited references in determining the obviousness of a claim. MPEP 2143.03. The patent law also requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings. MPEP 2142 and MPEP 2143.01. You cannot get motivation for producing true random numbers from a reference that teaches pseudorandom numbers. Further, a patent examiner must consider the whole of the teachings of the reference and not ignore the portion of a reference that teaches against the combination according to the invention. MPEP 2145 X.D.

The Office Action mentions the Declaration of Scott Wilbur submitted with a previous response, which included significant objective evidence of nonobviousness, but does not say why it should be dismissed. Objective evidence of nonobviousness must be considered when present and it is error to not consider it. MPEP 716.01(a). Thus, the Examiner's failure to discuss this in more detail is believed not to be proper.

The Examiner is invited to carefully read the application from page 1, line 8 through page 3, line 30. This discussion, which is fully supported by references provided in the IDS, shows that there was a long-felt need for the true random number generator claimed. Paragraphs 12 – 14 of the Declaration show that the invention has met that need, and is so unexpectedly superior to the prior art that the leading expert in random number generators has stated that it is the only device ever tested to pass all his randomness tests. This evidence is highly reliable because it is by a noted expert completely independent of the inventor. Further, the Declaration shows in paragraphs 15 – 26 that the invention has given rise to copying by others, which has created a new industry. Such evidence has been indicated by the Supreme Court of the United States to be highly probative of nonobviousness of this invention. MPEP 716.01(a), 716.02(a), 716.04, and 716.06.

For the above reasons, claims 59 – 66 are believed to be patentable and their reconsideration and allowance are respectfully requested. As indicated above, claims 57 and 58 are already indicated to be allowable. No additional fee is seen to be required. If

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any additional fee is required, please charge it to Deposit Account No. 50-1848.

Respectfully submitted,
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